



PATENT

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Applicant : Vance E. Bolding, et al.
Application No. : 10/089,577
Filed : March 29, 2002
Title : HORIZONTAL DRILL PIPE RACKER AND DELIVERY SYSTEM

Grp./Div. : 3652
Examiner : Janice Lee Krizek

Docket No. : 39373/HAC/G602

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
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October 30, 2003

Commissioner:

Applicants respond to the Office's action mailed October 1, 2003 in this application. That action is a restriction requirement, and sets a shortened statutory response period of one month. Applicant's response to the restriction requirement is twofold, namely, 1) a traverse of the requirement and 2) a provisional response to the requirement.

THE RESTRICTION REQUIREMENT

Restriction is required between allegedly restrictable inventions as follows:

- I. Claims 1 - 35 and 42 - 53; drill pipe storage apparatus and methods of storing drill pipe; Class 211, subclass 70.4; and
- II. Claims 36 - 41; drill pipe storage and handling apparatus; Class 414, subclass 22.62.

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The Office has observed that Inventions I and II are related as subcombinations disclosed as usable together in a single combination.

TELEPHONIC CONFERENCE OF OCTOBER 9, 2003

The action of October 1, 2003 was the subject of a telephone discussion on October 9, 2003 between the examiner and the undersigned, applicants' counsel. Counsel noted that the present application filed under 35 U.S.C. 371(c) is the national stage of a PCT application in which the PTO was both the ISA and the IPEA. In the PCT application, the PTO searched all claims and issued an IPER [Form PCT/IPEA/409] which stated that all claims, as amended, of the PCT application met the patentability criteria of PCT Article 33(2)-(4). Counsel noted that the claims of this § 371(c) national stage application are the same as the claims substantially "allowed" in the IPER. Thus, counsel noted that this § 371(c) application, because it was effectively allowed by the PTO in the international stage, qualified for the preferential basic fee under 37 CFR § 1.492(a)(4) and, for that reason, is subject to the limited prosecution provisions of 37 CFR § 1.496(b). That is, this § 371(c) national stage application is unusual because its predecessor international stage application was fully searched, fully examined, and allowed by the PTO in its role as ISA and IPEA in the international stage application.

The telephone discussion revealed that the examiner had not recognized the prior examination by the office of the present claims. It also appeared that it is possible that the examiner's national stage application file does not include copies of the ISR and IPER earlier issued by the Office concerning the present invention. For the convenience of the Office, copies of the earlier ISR and IPER are enclosed.

TRAVERSE OF THE RESTRICTION REQUIREMENT

The action of October 1, 2003, appears not to recognize that this application is a U.S. national stage application filed under 35 U.S.C. 371(c) in respect of a predecessor PCT Application which was filed in the USPTO as International Application PCT/US 00/27043. The

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PCT Application was searched in the USPTO, and was the subject of international preliminary examination in the USPTO.

The claims of the present application are the same as the amended claims in the predecessor PCT application. Those same claims were stated by the IPER to possess all of the PCT Article 34 criteria of patentability, namely (to use US terminology), utility, novelty and unobviousness. Thus, in the context of the PCT Application, the Office has found all claims herein (namely, claims 1 - 53) to be allowable. The allowable nature of the present claims is the reason why the basic filing fee for this application was paid at the minimum level under the provisions of 37 CFR § 1.492 (a)(4); the rationale for that low level of basic fee is that the PTO has determined that the claims are allowable in substance and that little or no examination effort is needed for the national stage applications. See 37 CFR § 1.496(b) which restricts the right of an applicant who pays a basic fee under § 1.492(a)(4) to amend the national stage application -- for the practical reason that the national stage claims have been "allowed" by the Office during the international stage proceedings.

To emphasize, present claims 1 - 53 have already been "allowed" by the Office in the international stage of this national stage application.

The substantive "allowance" of claims 1 - 53 in the PCT Application is material to the merits of the restriction requirement made in the Office action of October 1, 2003, in the present application. It is material because it shows the lack of existence in this application of a fundamental predicate for exercise by the Office of the discretion given it by 35 U.S.C. 121 to require restriction. 35 U.S.C. 121 states that "the Commissioner may require the application to be restricted" (emphasis added). Exercise of that discretion is conditioned upon a showing that efficient operation of the Office (i.e., efficient examination) will be the result of restriction. It is for that reason that MPEP 803 (Restriction – When Proper) states:

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"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions" (emphasis added)."

The action of October 1, 2003, does not state a proper basis for restriction because, on the facts of this application, there is no "serious burden" imposed on the Office by examination of the entire application. There is no serious burden because the Office can say "been there, done that" as to search and examination because of the Office's search, examination, and substantive allowance of all of the present claims in the predecessor PCT Application. Restriction in the present application is improper because there is no basis for exercising the discretion to require restriction.

MPEP appears not to mention anywhere the impact of 37 CFR § 1.496(b) and the special case presented where it is the PTO itself which has stated in an IPER that all claims later presented to it in a U.S. national stage application are allowable. The content of MPEP Chapter 800 is transparent to and does not recognize the special circumstances presented by an application filed under 35 U.S.C. 371(c) with claim to the benefit of 37 CFR § 1.492(a)(4). This is such an application.

For the reasons stated, the restriction requirement is traversed, and withdrawal of the requirement is requested.

PROVISIONAL RESTRICTION

Without detracting from the merits of applicants' traverse of the restriction requirement, they provisionally elect for prosecution herein, Invention I to which claims 1 - 35 and 42 - 53 are elected.

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CONCLUSION

Formal allowance of this application is requested to confirm the informal allowance of claims 1 - 53 by the IPER issued in the predecessor PCT Application.

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Respectfully submitted,

By


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626/795-9900

HAC/jmp

Enclosures: ISR and IPER

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